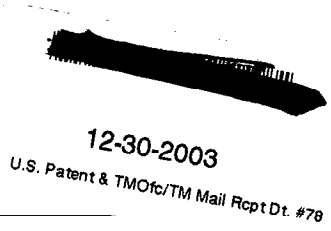
TTAB

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN RE: Tri/Mark Corporation	
SERIAL NO.: 76/159,890	Appeal No. _____
MARK: E-ACCESS	**REPLY BRIEF**
FILED: November 6, 2000	
CLASS: Int'l 9	
LAW OFFICE: 113	



To the Honorable Commissioner of Patents and Trademarks
ATTN: Assistant Commissioner for Trademarks
BOX: TTAB – Fee
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir:

Please enter the following Reply Brief into the record. It addresses arguments raised by the Examining Attorney in the Appeal Brief dated December 11, 2003 in support of the final refusal to register the above-stated mark.

01/14/2004 EPINA1 00000041 76159890
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CERTIFICATE OF MAILING

I hereby certify that the above correspondence was mailed to the Assistant Commissioner for Trademarks, Box TTAB - FEE, 2900 Crystal Drive, Arlington, VA 22202-3513, as first class mail, postage prepaid, this 22nd day of December, 2003.

Wendy K. Marsh

I. ARGUMENT

A. Amendment to the Supplemental Register

Appellant acknowledges the Examining Attorney's withdrawal of the rejection of the mark under Trademark Act Section 2(e)(1), and entry of the amendment to the Supplemental Register.

B. The Specimen of Record Demonstrates Use of "E-ACCESS" as a Source Indicator

1. The Examining Attorney Misconstrues the Legal Standards for Trademark Use

The Examining Attorney states that a mark does not function as a trademark for particular goods if that mark is not used properly in connection with the goods in trade, such that the proposed mark neither identifies the goods of the applicant nor indicates their source. (Examining Attorney's Brief, p. 4). The Examining Attorney then goes on to assert that the issue of whether "E-ACCESS" functions as a trademark turns on "whether the specimens are held to be packaging labels for the goods, or whether they are held to be advertising for the goods." (Examining Attorney's Brief, p. 4). The Examining Attorney cites to no supporting authority for this proposed statement of the issue. The reason for this is simple: there is no legal support for the Examining Attorney's assertion. Instead, the Examining Attorney has misstated the law by improperly combining portions of the TMEP § 1202 relating to "Use of Subject Matter as a Trademark" and § 904.05 which relates to "Material Not Appropriate as Specimens for Trademarks".

TMEP § 1202 states that if the Examining Attorney refuses registration on the ground that the subject matter is not used as a trademark:

> ...the Examining Attorney should explain the specific reason for the conclusion that the subject matter is not used as a trademark. *See* TMEP §§1202.01 through 1202.15 for a discussion of situations in which it may be appropriate, depending on the circumstances, for the examining attorney to

> refuse registration on the ground that the asserted trademark does not function as a trademark, *e.g.*, TMEP §§1202.01 (trade names), 1202.02(a) *et seq.* (functionality), 1202.03 (ornamentation), 1202.04 (informational matter), 1202.05 (color marks), 1202.06 (goods in trade), 1202.07 (columns or sections of publications), 1202.08 (title of single creative work), 1202.09 (names of artists and authors), 1202.10 (model or grade designations), 1202.11 (background designs and shapes), 1202.12 (varietal and cultivar names).

(Emphasis supplied). Thus, Section 1202 delineates the specific situations upon which the Examining Attorney may rely for a showing that the proposed mark fails to function as a trademark.

The theory upon which the Examining Attorney relies for failure to function as a trademark, i.e. that a proposed mark used on a product label that also contains advertising does not indicate source, is not included in the list of acceptable grounds upon which refusal is proper in Section 1202, nor can it be interpreted as tangentially falling under one of these categories. In this regard, at no time has the Examining Attorney asserted that "E-ACCESS" as shown on Appellant's product label merely functions as a tradename (§ 1202.01) or that it is does not meet the standards for showing non-functional trade dress (§ 1202.02). The Examining Attorney has also not ever asserted that "E-ACCESS" as shown on the product label is merely ornamentational (§ 1202.03), that it consists of a slogan that is merely informational in nature (§ 1202.04), that it merely consists of a functional color (§ 1202.05), or that the subject matter to which "E-ACCESS" is applied do not constitute "goods in trade" (§ 1202.06). Further, "E-ACCESS" is not a "column, section, or supplement of a printed publication" (§ 1202.07), the title of a creative work (§ 1202.08), the name of an artist or an author (§ 1202.09), a model or grade designation (§ 1202.10), a mere background design or shape (§ 1202.11), or a varietal or cultivar name (§ 1202.12).

Since the Examining Attorney's theory for non-use as a trademark is not described in Section 1202, the Examining Attorney's rejection must fail. The rejection for failure to function as a trademark should therefore be reversed.

2. "E-ACCESS" as Shown on the Specimen of Record is a Product Label AND Product Advertising

The Examining Attorney states that "the term E-ACCESS is featured only as part of a secondary advertisement for applicant's other goods." (Examining Attorney's Brief, p. 5). The Examining Attorney then states that, in other words, "the label contains a mark for the goods within the packaging, TRI MARK EASK, and also an advertisement for its other new line of products which consumers may wish to purchase, including E-ACCESS." (Emphasis supplied). These statements are simply wrong. Again, the Examining Attorney misstates the fact that the goods within the packaging on which the label is applied are the E-ACCESS goods. The nonsensical conclusion reached by the Examining Attorney in this case is that the specimen at issue would be acceptable for showing trademark use of TRI MARK or EASK even though the evidence of record shows only that E-ACCESS goods are provided in the packaging upon which the specimen of record is applied!

The Examining Attorney even argues that Applicant's position is that "all advertising wording on labels should be treated as a functioning trademark." (Examining Attorney's Brief, p. 6). Nothing in Appellant's brief supports such an interpretation. The conclusion that can be garnered from Appellant's brief, and likewise from TMEP § 904.04(a), however, is that "in most cases, where the trademark is applied to the goods or the containers for the goods by means of labels, a label is an acceptable specimen."

The bottom line is that the Examining Attorney has not and can not point to a single legal authority that states that placement of the trademark on a specimen consisting of a label placed on product packaging that also contains advertising does not support use as a trademark, thereby rendering the specimen improper. The rejection is therefore not proper and should be reversed.

C. Identification of Goods

In the interest of expediting prosecution, Appellant agrees to adopt the Examining Attorney's proposed identification of goods, so they would now read as follows:

Latches and handles having electronic locks for vehicular applications, namely, for fire trucks; latches and handles having electronic locks for freestanding industrial cabinets and enclosure systems that house and protect electrical data communications, instruments and control equipments, in Class 9;

Latches and handles having electronic locks for vehicular applications, namely, for agricultural and construction vehicles, motor homes, travel trailers, utility and service trucks, ambulances, bus and motor coaches, light, medium and heavy duty trucks, pick-up truck caps, fitted pick-up truck covers, fitted pick-up truck toolboxes, off-road vehicles in the nature of all-terrain vehicles, lawn tractors, and golf cars, in Class 12.

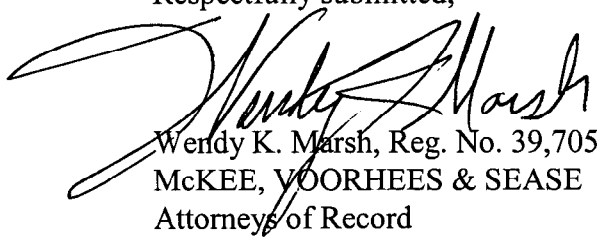
Appellant respectfully requests the amendment be entered into the record. Enclosed is a check for $335 for the additional class of goods.

III. CONCLUSION

For the above-stated reasons, Appelllant's submitted specimen is proper for showing trademark use. Appellant therefore respectfully requests that the Examining Attorney's final refusal to register dated December 13, 2001 be reversed and Appellant's mark forwarded for publication.

In the event that there is a fee due for this appeal other than the fee for the additional class of goods, please consider this a request to charge or debit Deposit Account No. 26-0084 accordingly.

Respectfully submitted,



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